



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/035,408

01/04/2002

David Wallach

WALLACH=17A

3196

1444

7590

09/26/2005

EXAMINER

EMCH, GREGORY S

BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

ART UNIT

PAPER NUMBER

1649

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/035,408	Applicant(s) WALLACH ET AL.	
	Examiner Gregory S. Emch	Art Unit 1649	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-36 and 39-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-36, 39-42, 45, 48, 50, 51, 54 and 56 is/are rejected.
- 7) ☒ Claim(s) 35, 36, 41-49, and 51-56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/894,626.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

580

DETAILED ACTION

Formal Matters

Claims 1-33, 37, and 38 were canceled and new claim 56 was added in the communication dated March 30, 2004. Currently, claims 34-36 and 39-56 are pending and under consideration. The finality of the last Office action is withdrawn, and new grounds of rejection are set forth below.

Response to Amendment and Arguments

The rejection of claims 40, 41, 50-56 under 35 U.S.C. 112, first paragraph is hereby withdrawn in view of Applicant's arguments in the communication dated July 22, 2005.

Claim Objections

Claims 35, 36, 41-49, and 51-56 are objected to because of the following informalities: The claims depend on rejected base claims. Appropriate correction is required.

Double Patenting

The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

Art Unit: 1649

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 34-36, 40-42, 45, 48, 51, 54, and 56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,808,891. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '891 patent discloses a method for isolating and identifying polypeptides capable of binding to a MORT-1 polypeptide and producing any polypeptide capable of binding to MORT-1 as in the instant claims. Further, the '891 patent discloses the additional limitations of applying the procedure of affinity chromatography as in claims 35 and 45 and of applying the yeast two-hybrid procedure as in claims 36 and 48.

Claims 34, 36, and 48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of copending Application No. 10/368,438. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '438 Application discloses a method for isolating and identifying proteins capable of binding to MORT-1 protein by applying the yeast two-hybrid procedure as in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 34, 36, and 48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/998,582. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '582 Application discloses a method for isolating and identifying proteins capable of binding to MORT-1 protein by applying the yeast two-hybrid procedure as in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 34, 39, 40, and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Horvath et al. (J. Cell Science, Suppl. 17: 223-228, 1993). The claims are directed to a method for isolating and identifying polypeptides capable of binding to the death domain motif of a regulatory protein containing a death domain, said regulatory protein being NGF-R, MORT-1 or ankyrin 1, comprising: assaying polypeptides to be tested, for binding to the death domain motif of said regulatory protein; and isolating and identifying any polypeptide that binds to said motif. Horvath et al. teach studies in which fibroblasts expressing each of the trk NGF receptors (trkA, trkB, and trkC) were crosslinked with iodinated NGF, and the crosslinked trk species were immunoprecipitated with polyclonal antibodies specific for the cytoplasmic domain of trk. In all cases, the antibody specifically recognized each trk receptor (see entire document, especially p.226). Since the death domain of NGF-R is located in the cytoplasmic domain, it is an inherent property of the antibodies and methods taught by the Horvath reference to bind the death domain, and thus meet the limitations of the polypeptides capable of binding to the death domain motif of NGF-R and the assaying, isolating and identifying steps of the claims. Further, the production of the antibodies is taught by the reference, thus meeting the additional limitation of claims 40. Since the reference teaches all the elements of the claims, claims 34, 39, 40, and 50 are anticipated by Horvath et al.

Art Unit: 1649

Conclusion

No claims are allowed.

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1649.

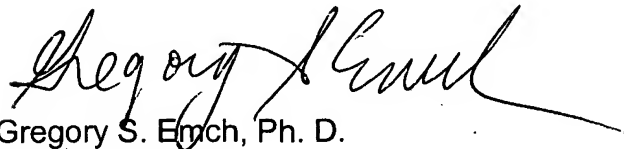
Art Unit: 1649

Advisory Information

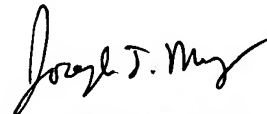
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory S. Emch whose telephone number is (571) 272-8149. The examiner can normally be reached on Monday through Friday from 8:30AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres can be reached at (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory S. Emch, Ph. D.
Patent Examiner
Art Unit 1649
September 20, 2005



JOSEPH MURPHY
PATENT EXAMINER